

REMARKS

This Amendment After Final is submitted in response to the Office Action, mailed September 1, 2005. Any fees that may be due in connection with the filing of this paper or with this application during its pendency may be charged to Deposit Account No. 06-1050. If a Petition for extension of time is needed, this paper is to be considered such Petition.

Claims 2-16, 18-27 and 44-47 are pending in this application. Claims 28 and 30-43 are cancelled herein without prejudice or disclaimer. Claims 9-11, 14, 15, 25-27 and 44-46 are amended herein.

I. REJECTION OF CLAIMS 9-11, 14, 15 AND 25-46 UNDER 35 U.S.C. §112, FIRST PARAGRAPH

Claims 9-11, 14, 15 and 25-46 are rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly fails to describe the claimed subject matter in such a way as to enable one skilled in the art to make and use the claimed subject matter. The Examiner alleges that there is no teaching in the specification or the prior art showing therapeutic effect of progesterone receptor agonists, that there are no working examples showing efficacy of the instant compounds in known animal models of any disease condition where progesterone receptor agonist activity is implicated, and that it would require undue experimentation to demonstrate efficacy of the claimed compounds in known animal models of all disease conditions where progesterone receptor agonists activity is implicated in their etiology. The Examiner also alleges that it would require undue experimentation to prepare different prodrugs of all the compounds encompassed by instant claims.

In order to expedite prosecution, but without acquiescing to the rejection, claims 28 and 30-43 are cancelled herein without prejudice or disclaimer. Thus, the rejection as applied to claims 28 and 30-43 is moot.

In order to expedite prosecution, but without acquiescing to the rejection, claims 9-11, 14, 15, 25-27 and 44-46 are amended herein to delete the recitation "or prodrug." Thus, the rejection as applied to claims 9-11, 14, 15, 25-27 and 44-46 is moot. Applicant respectfully requests reconsideration and withdrawal of the rejection.

II. THE REJECTION OF CLAIMS 9-11, 14, 15 AND 25-46 UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 9-11, 14, 15 and 25-46 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

A. Claims 9-11, 14, 15, 25-27 and 44-46

Claims 9-11, 14, 15, 25-27 and 44-46 are rejected as indefinite because the term "prodrug" is allegedly indefinite because "specific prodrugs and a method of preparing them are not defined" in the specification. In order to expedite prosecution, but without acquiescing to the rejection, claims 9-11, 14, 15, 25-27 and 44-46 are amended herein to delete the recitation "or prodrug." Thus, the rejection as applied to claims 1, 2 and 5-8 is moot.

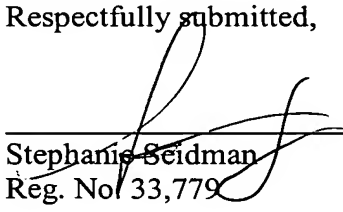
B. Claims 28 and 30-43

In order to expedite prosecution, but without acquiescing to the rejection, claims 28 and 30-43 are cancelled herein without prejudice or disclaimer. Thus, the rejection as applied to claims 28 and 30-43 is moot.

* * *

In view of the above, examination of the application on the merits and allowance is respectfully requested.

Respectfully submitted,



Stephanie Seidman
Reg. No. 33,779

Attorney Docket No. 18202-020001 / 1088
Address all correspondence to:
Stephanie Seidman
Fish & Richardson P.C.
12390 El Camino Real
San Diego, California 92130
Telephone: (858) 678-5070
Facsimile: (202) 626-7796
email: seidman@fr.com